IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

IN RE APPLICATION OF:	§	ATTY. DOCKET NO.: AUS920030562US1
	§	
DON RUTLEDGE DAY, ET AL.	§	EXAMINER: BRIAN P. WHIPPLE
	§	
SERIAL NO.: 10/631,059	§	CONFIRMATION NO.: 3506
	§	
FILED: 31 JULY 2003	§	ART UNIT: 2152
	§	
FOR: METHOD, SYSTEM AND	§	
PROGRAM PRODUCT FOR	§	
PROVIDING AUTOMATED	§	
SENDER STATUS IN A	§	
MESSAGING SESSION	§	

APPEAL BRIEF UNDER 37 C.F.R. 41.37

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Sir:

This Brief is submitted in support of the Appeal of the Examiner's final rejection of Claims 1-21 in the above-identified application. A Notice of Appeal was filed electronically in this case on October 15, 2007 and received in the United States Patent and Trademark Office on October 15, 2007. A three-month extension of time for filing the Appeal Brief is hereby requested. Please charge the fee of $1050.00 for a three-month extension of time to **DILLON & YUDELL DEPOSIT ACCOUNT No. 50-3083**. Please charge the fee of $510.00 due under 37 C.F.R. §1.17(c) for filing the brief, as well as any additional required fees, to **IBM CORPORATION DEPOSIT ACCOUNT No. 09-0447**.

REAL PARTY IN INTEREST

The real party in interest in the present Application is International Business Machines Corporation, the Assignee of the present application as evidenced by the Assignment set forth at reel 014365, frame 0770.

RELATED APPEALS AND INTERFERENCES

There are no other appeals or interferences known to Appellants, the Appellants' legal representative, or assignee, which directly affect or would be directly affected by or have a bearing on the Board's decision in the pending appeal.

STATUS OF CLAIMS

Claims 1-20 stand finally rejected by the Examiner as noted in the Final Office Action dated July 13, 2007 ("Final Office Action"). The rejection of Claims 1-20 under 35 U.S.C. §103(a) are appealed.

STATUS OF AMENDMENTS

No amendments to the claims have been made subsequent to the Final Office Action, from which this Appeal is filed.

SUMMARY OF THE CLAIMED SUBJECT MATTER

As set forth in independent **Claim 1**, "a method in a data processing system for managing a messaging session" (supported, for example, in the originally filed specification on p. 7, paragraph [0016] and FIG. 4) includes the steps of:

"detecting an input device activity by a participant with a messaging application" (supported, for example, on p. 15, paragraph [0030] and FIG. 4, step 405);

"resetting an internal timer within the messaging application in response to said detecting the input device activity by the participant with the messaging application" (supported, for example, at p. 15, paragraph [0030]);

"in response to said internal timer exceeding a specified time limit, determining the participant has disengaged activity in the messaging session" (supported, for example, on p. 15, paragraph [0030] and FIG. 4, step 410);

"determining a current activity of the participant, wherein said determining further comprises determining what application is receiving the input device activity by the participant" (supported, for example, on pp. 15-16, paragraph [0031] and FIG. 4, step 425);

"detecting a preference set by the participant, wherein said preference determines how a status indication is displayed to a message recipient" (supported, for example, on p. 16, paragraph [0032] and FIG. 3 and FIG. 5, participant status indicator); and

"transmitting the status indication in accordance with said preference to a message recipient in the messaging session, wherein the status indication indicates the current activity of the participant" (supported, for example, on p. 16, paragraph [0032] and FIG. 4, steps 430 and 440).

As set forth in **Claim 4**, "the method according to claim 1, wherein the message recipient specifies how the status indication is presented to the message recipient" (supported, for example, in the originally filed specification on p. 16, paragraph [0032], and FIG. 3, participant status indicator).

As set forth in independent **Claim 7**, "a data processing system for managing a messaging session" (supported, for example, in the originally filed specification on p. 7, paragraph [0016]; FIG. 1 and FIG. 2) includes the steps of:

"means for detecting an input device activity by a participant with a messaging application" (supported, for example, on p. 15, paragraph [0030] and FIG. 4, step 405);

"means for resetting an internal timer within the messaging application in response to said detecting the input device activity by the participant with the messaging application" (supported, for example, at p. 15, paragraph [0030];

"means, responsive to said internal timer exceeding a specified time limit, for determining the participant has disengaged activity in the messaging session" (supported, for example, on p. 15, paragraph [0030] and FIG. 4, step 410);

"means for determining a current activity of the participant, wherein said determining further comprises determining what application is receiving the input device activity by the participant" (supported, for example, on pp. 15-16, paragraph [0031] and FIG. 4, step 425);

"means for detecting a preference set by the participant, wherein said preference determines how a status indication is displayed to a message recipient" (supported, for example, on p. 16, paragraph [0032] and FIG. 3 and FIG. 5, participant status indicator); and

"means for transmitting the status indication in accordance with said preference to a message recipient in the messaging session, wherein the status indication indicates the current activity of the participant" supported, for example, on p. 16, paragraph [0032] and FIG. 4, steps 430 and 440).

As set forth in **Claim 10**, "the data processing system according to claim 7, wherein the message recipient specifies how the status indication is presented to the message recipient" (supported, for example, in the originally filed specification on p. 16, paragraph [0032], lines 3-14 and FIG. 3, participant status indicator).

As set forth in independent **Claim 13**, "an article of manufacture comprising a tangible machine-readable medium having stored thereon machine executable instructions" (supported, for example, in the originally filed specification on p. 7, paragraph [0016]; FIG. 1, mass storage device 18 and FIG. 2, client messaging applications 41a-n) wherein the instructions cause control circuitry to perform the steps of:

"detecting an input device activity by a participant with a messaging application" (supported, for example, on p. 15, paragraph [0030] and FIG. 4, step 405);

"resetting an internal timer within the messaging application in response to said detecting the input device activity by the participant with the messaging application" (supported, for example, at p. 15, paragraph [0030]);

"in response to said internal timer exceeding a specified time limit, determining the participant has disengaged activity in the messaging session" (supported, for example, on p. 15, paragraph [0030] and FIG. 4, step 410);

"determining a current activity of the participant, wherein said determining further comprises determining what application is receiving the input device activity by the participant" (supported, for example, on pp. 15-16, paragraph [0031] and FIG. 4, step 425);

"detecting a preference set by the participant, wherein said preference determines how a status indication is displayed to a message recipient" (supported, for example, on p. 16, paragraph [0032] and FIG. 4, step 425); and

"transmitting the status indication in accordance with said preference to a message recipient in the messaging session, wherein the status indication indicates the current activity of the participant" (supported, for example, on p. 16, paragraph [0032]; FIG. 3 and FIG. 5, participant status indicator).

As set forth in **Claim 16**, "the article of manufacture of Claim 13, wherein the message recipient specifies how the status indication is presented to the message recipient" (supported, for example, in the originally filed specification on p. 16, paragraph [0032], lines 3-14 and FIG. 3, participant status indicator).

GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

A.   The Examiner's rejection of Claims 1-3, 5-9, 11-15 and 17-20 under 35 U.S.C. §103(a) as being unpatentable over U.S. Publication No. 2004/0158609 A1 to *Daniell et al.* ("*Daniell*") in view of U.S. Publication No. 2004/0003042 A1 to *Horvitz et al.* ("*Horvitz*") is to be reviewed on Appeal.

B.   The Examiner's rejection of Claims 4, 10 and 16 under 35 U.S.C. §103(a) as being unpatentable over *Daniell* in view of *Horvitz*, and in further view of U.S. Pat. No 5,493,692 to *Theimer et al.* ("*Theimer*") is to be reviewed on Appeal.

ARGUMENTS

A.   The Examiner's rejection of Claims 1-3, 5-9, 11-15 and 17-20 under 35 U.S.C. §103(a) as being unpatentable over *Daniell* in view of *Horvitz* is to be reviewed on Appeal.

1.   The Examiner's rejection of Claims 1-3, 5-9, 11-15 and 17-20 is improper because the combination of *Daniell* with *Horvitz* does not render obvious the step of determining the current activity of the participant wherein said determining further comprises determining what application is receiving the input device activity by the participant.

Regarding the rejection of exemplary Claim 1, the combination of *Daniell* with *Horvitz* does not render obvious the step of determining the current activity of the participant wherein said determining further comprises determining what application is receiving the input device activity by the participant. On page 3 of the Final Office Action, the Examiner states, "*Daniell* is silent on said determining further comprises determining what application is receiving the input device activity by the participant. However, *Horvitz* discloses said determining further

comprises determining what application is receiving the input device activity by the participant (Abstract, ln. 8-11; [0100], ln. 7-11)."

However, *Horvitz* discloses presence forecasts that include a user's current or future locations at different levels of location precision and usage of different devices or applications (Abstract, lines 8-11). The presence forecasts of *Horvitz* are <u>probabilistic predictions</u> of a user's location and usage of different devices or applications (paragraph [0007], lines 11-13). The presence forecasts of *Horvitz* do not comprise determining what application is receiving the input device activity by a messaging participant, as claimed. *Horvitz* also discloses "an event sensing and abstraction system that senses computer events from an operating system and applications executed on the client" (paragraph [0100], lines 7-11). *Horvitz* assumes multiple applications executing on a client device. However, there is no teaching of using sensed computer events to determine which application of the multiple applications executed on the client device is receiving input device activity by the participant. Assuming this teaching of *Horvitz* is used to modify *Daniell*, the combination of *Daniell* and *Horvitz* does not render obvious the step of determining the current activity of the participant wherein said determining further comprises determining what application is receiving the input device activity by the participant, as claimed.

2.   The Examiner's rejection of Claims 1-3, 5-9, 11-15 and 17-20 is improper because a person having ordinary skill in the art would not be motivated to combine *Daniell* with *Horvitz* to achieve Apellants' invention.

Regarding the rejection of exemplary Claim 1, it would not be obvious to a person having ordinary skill in the art at the time of the invention to combine *Daniell* with *Horvitz*. The Examiner states on p. 3 of the Final Office Action, "It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the teachings of *Daniell* <u>by determining what application is receiving input device activity by a participant as taught by *Horvitz*</u> in order to facilitate real-time, peri-real time, and/or long-term planning for messaging and collaboration by providing information on a user's location and/through application usage (Horvitz: [0007], ln. 9-17)". However, *Horvitz* discloses "the present invention facilitates real-time, peri-real time, and/or long-term planning for messaging and collaboration by providing

probabilistic predictions about current and future states of users to authorized persons and/or automated applications (e.g., states such as time until someone will arrive or leave a location, will be at a location for time at least time t, time will have access to a device, time will review e-mail, time will finish a conversation in progress, time will attend a meeting, and so forth)." (*Horvitz*, paragraph [0007], lines 9-17) For example, *Horvitz* teaches examining a user's electronic calendar application (e.g. Outlook) to determine if a meeting is scheduled (paragraph [0100], lines 14-17). *Horvitz* does not teach determining what application is receiving input device activity by a participant in order to facilitate real-time, peri-real time, and/or long-term planning for messaging and collaboration by providing information on a user's location and/through application usage. It would not be obvious to a person having ordinary skill in the art to modify *Daniell* to include the step of determining what application is receiving input device activity by a participant based on the teachings of *Horvitz*.

The rejection of exemplary Claim 1, as well as independent Claims 7 and 13, are therefore improper and should be reversed in view of the arguments set forth herein regarding the rejection of exemplary Claim 1. Claims 2-3, 5-6, 8-9, 11-12, 14-15 and 17-20 depend directly or indirectly from independent Claims 1, 7 and 13, which have been improperly rejected in view of the cited art. The rejection of Claims 2-3, 5-6, 8-9, 11-12, 14-15 and 17-20 is likewise improper and should be reversed in view of the arguments put forth herein regarding the rejection of independent Claims 1, 7 and 13.

B. **The Examiner's rejection of Claims 4, 10 and 16 under 35 USC 103(a) as being unpatentable over *Daniell* in view of *Horvitz* in further view of *Theimer* is to be reviewed on Appeal.**

Regarding the rejection of exemplary Claim 4, the combination of *Daniell, Horvitz* and *Theimer* does not render obvious the step of transmitting the status indication in accordance with said preference to a message recipient in the messaging session, wherein the status indication indicates the current activity of the participant. On p. 6 of the Final Office Action, the Examiner states that "*Daniell* and *Horvitz* disclose the invention substantially as in parent claim 1, including presenting a status indication to a message recipient (Abstract, ln, 10-13; [0093], ln. 1-5), but are silent on the message recipient specifies how the indication is presented to the message recipient." The Examiner then states, "Theimer discloses the message recipient specifies how the indication is presented to the message recipient (Fig. 1; Col. 24, ln. 8-48)." However, *Theimer* does not disclose that the message recipient specifies how the indication is presented to the message recipient. *Theimer* teaches an application of selective electronic message delivery wherein a user may wish to receive a message reminding him of a meeting with another user (col. 24, lines 1-3), but, for example, may not wish to have the reminder sent if there are other people present in proximity to his display device (col. 24, lines 17-19). *Theimer* therefore does not teach <u>how</u> the indication of the current activity of a participant is presented to the message recipient, but whether or not the message itself is sent or not sent, depending upon certain predefined conditions.
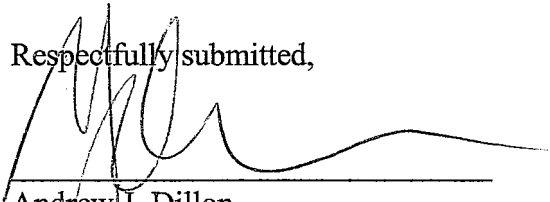
Furthermore, the combination of *Daniell* and *Horvitz* do not disclose the invention substantially as in exemplary Claim 1. The combination of *Daniell* and *Horvitz* do not disclose or render obvious the step of determining what application is receiving input device activity by a participant, for the reasons set forth herein regarding the rejection of exemplary Claim 1. *Theimer* is silent as to determining what application is receiving input device activity by a participant. Therefore the combination of *Daniell, Horvitz* and *Theimer* does not render obvious the step of determining the current activity of the participant wherein said determining further comprises determining what application is receiving the input device activity by the participant.

The rejection of exemplary Claim 4, as well as Claims 10 and 16, are therefore improper and should be reversed in view of the arguments set forth herein regarding the rejection of exemplary Claim 4.

CONCLUSION

Appellants have pointed out with specificity the manifest error in the Examiner's rejections, and the claim language which renders the invention patentable over the various combinations of references. Appellants, therefore, respectfully request the reversal of the rejections of all pending claims.

Respectfully submitted,

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CLAIMS APPENDIX

1. A method in a data processing system for managing a messaging session, said method comprising the steps of:

    detecting an input device activity by a participant with a messaging application;

    resetting an internal timer within the messaging application in response to said detecting the input device activity by the participant with the messaging application;

    in response to said internal timer exceeding a specified time limit, determining the participant has disengaged activity in the messaging session;

    determining a current activity of the participant, wherein said determining further comprises determining what application is receiving the input device activity by the participant;

    detecting a preference set by the participant, wherein said preference determines how a status indication is displayed to a message recipient; and

    transmitting the status indication in accordance with said preference to a message recipient in the messaging session, wherein the status indication indicates the current activity of the participant.

2. The method according to claim 1, wherein the status indication is a textual message to the message recipient.

3. The method according to claim 1, wherein the status indication is a graphic presented to the message recipient.

4. The method according to claim 1, wherein the message recipient specifies how the status indication is presented to the message recipient.

5. The method according to claim 1, wherein the step of determining a current activity of the participant comprises determining a current activity of the participant with a hardware system component of the data processing system

6. The method according to claim 1, wherein the step of determining a current activity of the

participant comprises determining a current activity of the participant with a software system component of the data processing system.

7. A data processing system for managing telephone numbers contained within a web page in accordance with user preferences, said system comprising:

means for detecting an input device activity by a participant with a messaging application;

means for resetting an internal timer within the messaging application in response to said detecting the input device activity by the participant with the messaging application;

means, responsive to said internal timer exceeding a specified time limit, for determining the participant has disengaged activity in the messaging session;

means for determining a current activity of the participant, wherein said determining further comprises determining what application is receiving the input device activity by the participant;

means for detecting a preference set by the participant, wherein said preference determines how a status indication is displayed to a message recipient; and

means for transmitting the status indication in accordance with said preference to the message recipient in the messaging session, wherein the status indication indicates the current activity of the participant.

8. The data processing system according to claim 7, wherein the status indication is a textual message to the message recipient.

9. The data processing system according to claim 7, wherein the status indication is a graphic presented to the message recipient.

10. The data processing system according to claim 7, wherein the message recipient specifies how the status indication is presented to the message recipient.

11. The data processing system according to claim 7, wherein the means for determining a current activity of the participant comprises means for determining a current activity of the

participant with a hardware system component of the data processing system.

12. The data processing system according to claim 7, wherein the means for determining a current activity of the participant comprises means for determining a current activity of the participant with a software system component of the data processing system.

13. An article of manufacture comprising a tangible machine-readable medium having stored thereon machine executable instructions that cause control circuitry to perform the steps of:

       detecting an input device activity by a participant with a messaging application;

       resetting an internal timer within the messaging application in response to said detecting the input device activity by the participant with the messaging application;

       in response to said internal timer exceeding a specified time limit, determining a participant has disengaged activity in the messaging session;

       determining the current activity of the participant, wherein said determining further comprises determining what application is receiving the input device activity by the participant;

       detecting a preference set by the participant, wherein said preference determines how a status indication is displayed to a message recipient; and

       transmitting the status indication in accordance with said preference to the message recipient in the messaging session, wherein the status indication indicates the current activity of the participant.

14. The article of manufacture of Claim 13, wherein the status indication is a textual message to the message recipient.

15. The article of manufacture of Claim 13, wherein the status indication is a graphic presented to the message recipient.

16. The article of manufacture of Claim 13, wherein the message recipient specifies how the status indication is presented to the message recipient.

17. The article of manufacture of Claim 13, wherein the step of determining a current activity of

the participant comprises determining a current activity of the participant with a hardware system component of the data processing system.

18. The article of manufacture of Claim 13, wherein the step of determining a current activity of the participant comprises determining a current activity of the participant with a software system component of the data processing system.

19. The method of Claim 1, wherein the current activity of the participant comprises utilization of a telephone system during the messaging session.

20. The method of Claim 19, wherein the data processing system for managing a messaging session includes said telephone system.

EVIDENCE APPENDIX

Other than the Office Action(s) and reply(ies) already of record, no additional evidence has been entered by Appellants or the Examiner in the above-identified application which is relevant to this appeal.

RELATED PROCEEDINGS APPENDIX

There are no related proceedings as described by 37 C.F.R. §41.37(c)(1)(x) known to Appellants, Appellants' legal representative, or assignee.